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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,098	11/21/2003	Terrence A. Tomkow	RPOST-66231	1930
24201 7590 07/10/2008 FULWIDER PATTON LLP HOWARD HUGHES CENTER 6060 CENTER DRIVE, TENTH FLOOR LOS ANGELES, CA 90045			EXAMINER GELAGAY, SHEWAYE	
			ART UNIT 2137	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/719,098

Applicant(s)

TOMKOW, TERRENCE A.

Examiner

SHEWAYE GELAGAY

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/4/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/4/08 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 4/4/08 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7 and 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomkow WIPO Publication WO 01/10090 in view of Dickie et al. (hereinafter Dickie) US 6,643,687.

As per claims 1 and 11:

Tomkow teaches a method of transmitting a message from a sender to a recipient through a server displaced from the recipient, including the steps at the server of: receiving the message at the server from the sender, (page 4, lines 6-9) transmitting

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the message from the server to the recipient, (page 4, lines 9-11) and providing for a transmission of a reply to the sender through the server of the message by the recipient. ((page 10, line 5-page 11, line 14; page 20, line 10-page 21, line 6; page 31, line 24-page 32, line 6) Tomkow does not explicitly disclose reply not originating on the server. Dickie in analogous art, however, teaches reply not originating on the server. (col. 5, line 3-col. line 54) Therefore it would have been obvious to one ordinary Tomkow with Dickie in order to provide an email system that improves security issue by facilitating automatic filtering of email messages. (col. 1, lines 33-50; Dickie)

As per claim 2:

The combination of Tomkow and Dickie teaches all the subject matter as discussed above. In addition, Tomkow further teaches the message is provided with a unique identification by the server and wherein the reply from the recipient through the server to the sender is provided on the basis of this unique identification of the message by the server. (page 16, line 1-15)

As per claim 3:

The combination of Tomkow and Dickie teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the reply by the recipient through the server provides for an identification of each of a plurality of recipients on the basis of individual identifications related to the unique identification of the message. (page 16, lines 10-23)

As pr claim 4:

The combination of Tomkow and Dickie teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the message from the sender to the recipient is provided in a particular format at the server. (page 16, lines 24-28)

As per claims 5 and 16:

The combination of Tomkow and Dickie teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the reply includes a request from the recipient to receive proof of transmission or delivery of the reply and wherein the server responds to the request in the reply to provide the proof of the transmission or delivery of the reply to the sender. (page 6, lines 6-25; page 16, lines 16-28)

As per claims 6 and 16:

The combination of Tomkow and Dickie teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the recipient provides a fictional destination address and wherein the destination address is at the server and wherein a database associated with the server stores the identity of the message and the identity and address of the sender and wherein the reply includes an identification of the message and the name and address of the sender and wherein the server parses the message and the name and address of the sender from the fictional destination address and directs the reply to the sender at the sender's address. (page 10, line 5-page 11, line 14; page 31, line 24-page 32, line 6)

As per claims 7 and 12:

The combination of Tomkow and Dickie teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the reply by the recipient through the server provides for an identification of each of a plurality of recipients on the basis of individual identifications related to the unique identification of the message and wherein the message from the sender to the recipient is provided in a particular format at the server and wherein the reply includes a request from the recipient to receive proof of transmission or delivery of the reply and wherein the server responds to the request in the reply to provide the proof of the transmission or delivery of the reply to the sender and wherein the recipient provides a fictional destination address and wherein the destination address is at the server and wherein a database associated with the server stores the identity of the message and the identity and address of the sender and wherein the reply includes an identification of the message and the name and address of the sender and wherein the server parses the message and the name and address of the sender from the fictional destination address and directs the reply to the sender at the sender's address. (page 10, line 5-page 11, line 14; page 20, line 10-page 21, line 6; page 31, line 24-page 32, line 6)

As per claim13:

The combination of Tomkow and Dickie teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the message is provided with a unique identification by the server and wherein the sender is provided with a unique identification related to the unique identification of the message and wherein the server determines the identification and address of the sender through the identification

of the message and wherein the server transmits the reply to the address of the sender.  
(page 16, lines 1-15; page 20, line 10-page 21, line 6)

As per claim 10:

The combination of Tomkow and Dickie teaches all the subject matter as discussed above. In addition, Tomkow teaches wherein the reply by the recipient through the server provides for an identification of each of a plurality of recipients on the basis of individual identifications related to the individual identification of the message.  
(page 6, lines 6-25; page 16, lines 16-28)

As per claims 9 and 14:

Tomkow teaches transmitting a message from a sender to a recipient through a server displaced from the recipient, including the steps at the server of: receiving the message from the sender, providing a message with a unique identification by the server, providing the sender unique identification related to the unique identification of the message by the server, transmitting the message from the server to the recipient, storing the unique identification of the message and the sender including an address of the sender in a database by the server, determining by the server the identification and address of the sender through the identification of the message stored in the database, locating in the database the identification of the message and the sender, and transmitting by the server the reply to the address of the sender. (page 10, line 5-page 11, line 14; page 31, line 24-page 32, line 6) Tomkow does not explicitly disclose transmitting to the sender through the server any reply by the recipient to the sender. Dickie in analogous art, however, teaches by the server the replay to the address of the

sender. Tomkow does not explicitly disclose reply transmitting to the sender through the server any reply by the recipient to the sender. Dickie in analogous art, however, teaches reply not originating on the server. Therefore it would have been obvious to one ordinary Tomkow with Dickie in order to provide an email system that improves security issue by facilitating automatic filtering of email messages. (col. 1, lines 33-50; Dickie)

As per claim 17:

The combination of Tomkow and Dickie teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein a delivery receipt is generated from the reply from the recipient to the sender and wherein the delivery receipt is transmitted to the sender and the recipient. (page 22, line 15-page 23, line 30)

As per claim 18:

The combination of Tomkow and Dickie teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the message is provided with a particular format and wherein the message is transmitted to the recipient in the particular format. (page 15, line 13-page 16, line 23)

As per claim 19:

The combination of Tomkow and Dickie teaches all the subject matter as discussed above. In addition, Tomkow further teaches a wherein the reply from the recipient is sent registered from the server to the sender and wherein a delivery receipt is generated for the reply and wherein the delivery receipt is transmitted to the sender



and the recipient. (page 15, line 13-page 16, line 23)

As per claim 20:

The combination of Tomkow and Dickie teaches all the subject matter as discussed above. In addition, Tomkow further teaches wherein the server also sends the reply to the recipient to confirm that the recipient has sent the reply to the sender the message is provided with a particular format and wherein the message is transmitted to the recipient in the particular format and wherein the reply from the recipient is sent registered from the server to the sender and wherein a delivery receipt is generated for the reply and wherein the delivery receipt is transmitted to the sender and the recipient. (page 25, lines 4-30)

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1, 9, 11 and 14 are rejected under 102(e) as being anticipated by Liu et al. (hereinafter Liu) US 6,760,752.

As per claims 1 and 11:

Liu teaches a method of transmitting a message from a sender to a recipient through a server displaced from the recipient, including the steps at the server of: receiving the message at the server from the sender, transmitting the message from the server to the recipient, and providing for a return transmission of a reply from the

recipient to the sender, the reply not originating on the server. (col. 6, line 32-col. 7, line 20; co. 13, line 25-col. 15, line 3; col. 27, line 31-col. 28, line 3; col. 29, line 51-col. 30, line 38)

As per claims 9 and 14:

Liu teaches transmitting a message from a sender to a recipient through a server displaced from the recipient, including the steps at the server of: receiving the message from the sender, providing a message with a unique identification by the server , providing the sender unique identification related to the unique identification of the message by the server, transmitting the message from the server to the recipient, storing the unique identification of the message and the sender including an address of the sender in a database by the server, determining by the server the identification and address of the sender through the identification of the message stored in the database, locating in the database the identification of the message and the sender, and transmitting by the server the reply to the address of the sender.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEWAYE GELAGAY whose telephone number is (571)272-4219. The examiner can normally be reached on 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. G./

Examiner, Art Unit 2137

/Emmanuel L. Moise/

Supervisory Patent Examiner, Art Unit 2137